

PATENT IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: DAI, D., <i>et al.</i>	EXAMINER: DENTZ, BERNARD I.
SERIAL NO.: 10/584,114	ART UNIT: 1625
FOR: TRIPTOLIDE 5,6-DERIVATIVES AS IMMUNOMODULATORS AND ANTICANCER AGENTS	CONFIRMATION NO.: 3360

STATEMENT OF FACTS UNDER 37 C.F.R. §1.705(b)(2) IN SUPPORT OF
REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

Mail Stop Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This statement of facts is being submitted in support of a Request for Recalculation of Patent Term Adjustment (PTA) in the above-referenced patent application, and is timely submitted before payment of the issue fee. Consideration of the remarks presented herein is respectfully requested.

With the Notice of Allowance mailed 14 June 2010, the estimated patent term was 577 days. However, this application was filed as a national phase filing under 35 U.S.C. § 371, and Applicants note that, under 37 C.F.R. § 1.702(b), for a national phase filing, the actual filing date is the date that the national stage commenced under 35 U.S.C. § 371(b) or (f) (*i.e.*, 30-months from the earliest priority date, or when applicant explicitly requests early processing, respectively), rather than under 35 U.S.C. § 371(c) (the date that the executed inventor declaration was filed). Applicants believe the Patent Office has improperly used the 35 U.S.C. § 371(c) date (*i.e.*, 21 May 2007) for the present application in its calculation, while the actual filing date of 23 June 2006 is the date from which Patent Term Adjustment should be calculated.

Applicants submit that, due to an incorrect PTA calculation under 37 C.F.R. 1.702(b), the correct Patent Term Adjustment should be at least an additional 1031 days.

1. Statement of facts

Applicants' calculations for the correct PTA follow. PTA calculation for the 10/584,114 application begins with its filing under 35 U.S.C. § 371(b) on 23 June 2006. The difference in the number of days from 23 June 2006 (the actual filing date) to 21 May 2007 (the date the Patent Office used as the filing date for PTA calculation) is 332 days, which, when added to the estimated 577 days appearing on the Notice of allowance, is 909 days of PTA.

There are two instances of Patent Office delay under 37 C.F.R. §§ 1.702(a) and 1.702(b) that would lead to an addition of PTA days and no instances of Applicant delay under 37 C.F.R. §1.704 that would lead to a reduction in PTA days.

1. Under 35 U.S.C. §154(b)(1)(A)(i) and 37 C.F.R. §1.702(a)(1), the Office must mail a notification under 35 U.S.C. §132 or a notice of allowance under 35 U.S.C. §151 not later than 14 months after the filing date of the application. Because the filing date of the application was 23 June 2006, an Office Action was due 23 August 2007. However, the first Office Action was not sent until 18 February 2010. The Office's delay in mailing this first action results in a credit of 909 days PTA.
2. Under 35 U.S.C. §154(b)(1)(B) and 37 C.F.R. §§1.702(b) and 1.703(b), the Office must issue a patent within three years after the date on which the application was filed (*i.e.*, the date national stage commenced under 35 U.S.C. § 371(b) or (f)). Because the filing date of the application was 23 June 2006, the expiry of the 3-year period to issue was 23 June 2009. Because days of credit are not counted twice, the period from 24 June 2009 until 18 February 2010 in the calculation of point 1 above will already be credited. However, additional days of credit from 19 February 2010 until the date of issuance should be received for the period B day. For example, if the patent were to issue today, the Patent Office delay would result in a credit of at least an additional 122 days PTA.
6. Thus, the total number of days of PTA should be the sum of [(909 days + at least 122 days = 1031 days of credit due to Office delays) and no days of debit due to Applicant delays = 1031 days].

Applicants respectfully request reconsideration and a recalculation of the Patent Term Adjustment indicated on the Notice of Allowance, mailed 14 June 2010 for the above-identified application. Applicants herein apply for an adjustment of the patent term due to a net delay in examination by the Patent Office.

2. Payment of fee under §1.18(e)

The required fee under 37 C.F.R. §1.18(e) accompanies this statement of facts in support of this application, and Applicants hereby authorizes the Patent Office to charge any other fees that may be due to Deposit Account 50-4616. Because this request is being filed before the payment of issue fee, it is timely filed.

Respectfully submitted,
KING & SPALDING LLP

Date: 21 June 2010

/Susan J. Myers Fitch/
Susan J. Myers Fitch
Reg. No. 55,477

Correspondence Address:
Customer No. 79975

KING & SPALDING LLP
333 TWIN DOLPHIN DRIVE
SUITE 400
REDWOOD SHORES, CA 94065
TEL: (650) 590-0700
FAX: (650) 590-1900
WWW.KSLAW.COM